

REMARKS

Entry of the foregoing, reexamination and reconsideration of the application identified in caption, as amended, pursuant to and consistent with 37 C.F.R. §1.111 and in light of the remarks which follow, are respectfully requested.

By the above amendments, claim 8 has been amended for readability purposes to recite "comprising dissolving an oil-soluble dye in a high boiling point organic solvent," and "wherein a high-pressure emulsifying and dispersing device emulsifies and disperses said oil-soluble dye." Claim 16 has been amended for readability purposes to recite "comprising recording an ink-jet ink onto an image receiving material, wherein the ink-jet ink includes . . ."

In the Official Action, claims 8-17 stand rejected under 35 U.S.C. §112, second paragraph, for the reasons set forth at page 2 of the Official Action. Specifically, the Patent Office has taken the position that claims 8 and 16 are indefinite for reciting the term "using." In this regard, the Patent Office has stated that "a 'process' defined in the sole terms of 'using' does not define patentable subject matter under 35 U.S.C. 101 [emphasis added]." However, claims 8 and 16 recite method steps in addition to the objected-to term "using." For example, claim 8 recites "dissolving an oil-soluble dye," and claim 16 recites "recording an ink-jet ink onto an image receiving material." For at least this reason, the objected-to term "using" does not render claims 8 and 16 indefinite. See M.P.E.P. §2173.05(q).

Claims 8 and 16 have been amended for readability purposes by deleting the objected-to term "using" and reciting the phrases "a high-pressure emulsifying and dispersing device emulsifies and disperses said oil-soluble dye," and "recording an ink-jet ink onto an image

receiving material," respectively. Accordingly, withdrawal of the §112, second paragraph rejection is respectfully requested.

Claims 1-17 have been provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being obvious over claims 1-19 of copending Application No. 09/819,802; claims 1-20 of copending Application No. 09/800,779 (now U.S. Patent No. 6,521,031); and claims 1-18 of copending Application No. 09/800,572.

Without addressing the propriety of these rejections, and in order to expedite prosecution of the present application, submitted herewith is a Terminal Disclaimer with respect to the '802 and '572 applications, as well as a Terminal Disclaimer with respect to the '031 patent. The filing of such Terminal Disclaimers is effective to overcome the present obviousness-type double patenting rejections. Accordingly, withdrawal of the rejections is respectfully requested.

The Patent Office has required a showing that the inventions of Application Nos. 09/800,572, 09/800,779 and 09/819,802, were commonly owned at the time the invention in the present application was made. In response thereto, attached is a Statement Under 37 C.F.R. §1.78(c) made by the assignee of the present application, which states that "at the time the present invention was made, the present application and U.S. Patent Application Nos. 09/800,572, 09/800,779 and 09/819,802 were each owned by or subject to an obligation of assignment to Fuji Photo Film Co., Ltd." Consideration of the Statement Under 37 C.F.R. §1.78(c) is respectfully requested.

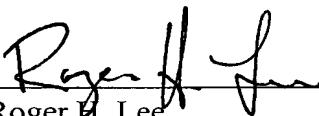
From the foregoing, further and favorable action in the form of a Notice of Allowance is believed to be next in order, and such action is earnestly solicited.

Application No. 09/800,778
Attorney's Docket No. 003510-082

If there are any questions concerning this paper or the application in general, the Examiner is invited to telephone the undersigned.

Respectfully submitted,

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Application No. 09/800,778
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**Attachment to AMENDMENT AND SUBMISSION OF TERMINAL
DISCLAIMERS AND STATEMENT UNDER 37 C.F.R. §1.78(c)
dated March 13, 2003**

Marked-up claims 8 and 16

8. (Amended) A method of manufacturing an ink-jet ink, comprising dissolving [in which] an oil-soluble dye [is dissolved] in a high boiling point organic solvent which has a boiling point of 150°C or more and has a specific inductive capacity at 25°C of 3 to 12, and wherein a high-pressure emulsifying and dispersing device emulsifies and disperses said oil-soluble dye [being emulsified and dispersed] at a pressure of 50 MPa or more [using a high-pressure emulsifying and dispersing device].

16. (Amended) An ink jet recording method comprising [in which] recording [is carried out] an ink-jet ink onto an image receiving material, wherein the [using an] ink-jet ink [which] includes a dye dispersed product, an oil soluble dye being dissolved in a high boiling point organic solvent which has a boiling point of 150°C or more and has a specific inductive capacity at 25°C of 3 to 12, said oil-soluble dye being emulsified and dispersed in a water-based medium, and said dye dispersed product being formed.